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09/781,329	02/13/2001	Koji Fukumoto	826.1675/JDH	9064
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER  NASH, LASHANYA RENEE	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/781,329

**Applicant(s)**

FUKUMOTO ET AL.

**Examiner**

LASHANYA R. NASH

**Art Unit**

2153

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This Office action is in response to request for continued examination filed 1 February 2008. Claims 1-2 and 4-10 are presented for further consideration. Claim 3 is cancelled. Claim 10 is new.

### ***Response to Arguments***

Applicant's arguments filed 1 February 2008 have been fully considered but they are not persuasive.

In considering the Applicant's arguments the following factual remarks are noted:

(I) Applicant contends that Gilbert and Shaughnessy individually or in combination do not teach "the keyword information is designated by the sender and different for respective receivers".

In considering (I), Applicant contends that Gilbert and Shaughnessy individually or in combination do not teach "the keyword information is designated by the sender and different for respective receivers". Examiner respectfully disagrees. Examiner asserts that Gilbert explicitly teaches the e-mail emphasizing method and system wherein the sender (i.e. originating user) designates information, that is different for each of the respective receivers, in order to subsequently emphasize that information for the aforementioned designated recipient in an e-mail transmission (column 4, lines 59-61; column 5,

lines 6-16). Specifically, Gilbert discloses a sender (i.e. originating user) that designates different portions of a broadcast e-mail message to be emphasized differently associated with the receiving user, as a specific portion of an e-mail (i.e. "finish testing the new prototypes"; Figure 5-item 120) is in italics only for a recipient "John" (column 8, lines 19-31) and another portion of the e-mail message (i.e. "complete sales plan by Thursday"; Figure 5-item 130) is bold only for the recipient "Fred" (column 8, lines 32-37). Therefore, Gilbert expressly teaches a sending user designating different actions that is to be applied for different e-mail portions for each of the respective receivers. Examiner additionally notes that the Shaughnessy reference has been replaced with a newly found prior art reference Armstrong (US Patent 6, 356,633) as set forth in the rejection below, in order to clearly teach Applicant's claim.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: amending claim 5 to recite "A computer-readable storage medium" as properly supported by the specification, (see Specification pages 21-22).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language is vague and indefinite as the preamble of the aforementioned claim (lines 1-2) is directed to a system, which is defined in the specification as hardware (See Specification, page 7; Figure 2). However, the body of the claim (lines 3-10) is only directed to software (i.e. program propagated by signals). There are no limitations within the body of the claim, regarding hardware components interconnected with the program in order to realize the functionality of system.

Examiner additionally notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As previously discussed, claim 8 comprises a system which is directed to a program itself, without a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize the functionality. Therefore the system is considered software per se, and fails to fall within a statutory category of invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1,2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert (US Patent 6,529,942) and further in view of Armstrong (US Patent 6,356,633), hereinafter referred to as Gilbert and Armstrong.**

Gilbert teaches an email system and method which allows the originating user to customize text for a specific recipient in a multiple recipient email system (i.e. broadcast), (abstract).

In reference to claim 1, Gilbert shows that the E-mail system with recipient-specific content system includes:

- A receiving device (i.e. receiver; Figure 1-receiver) receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, (column 3, line 24 to column 4, line 30); and
- A storing device (i.e. memory; column 3, lines 34-41) storing information predetermined for respective receivers (i.e. identifier codes; column 6, lines 10-31; column 7, lines 8-24), wherein the information is designated by the sender and different for respective receivers (e.g. John is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5);
- An emphasizing device (i.e. network computer of sender) emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67) different parts the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing E-mail information (i.e. embedding text format commands and identifier codes; column 8, lines 1-18) including all of the transmission information with the transmission information in which the different parts are for respective receiver (columns 5-7; Figure 5),

- A transmitting device transmitting the E-mail information including all of the transmission information to respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 8, line 44 to column 9, line 18).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach a storing device storing, independent of receiving the transmission information, keyword information predetermined for respective receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a system for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device, independent of receiving the transmission information, keyword information predetermined for respective receivers (i.e. pre-defined keyword list used to route messages to particular agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known storing device element of the email system for emphasizing recipient-specific content, as taught by Gilbert, with the known element of a storing device for storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to there respective functions



to yield the predictable result of subsequently highlighting predetermined keywords associated with users that are included in Emails.

In reference to claim 2, Gilbert shows receiving device that receives a part of the transmission information that the sender designates and information about a corresponding transmission destination and emphasizing device that emphasizes and highlights the designated part and prepares E-mail information for a receiver corresponding to the transmission destination, (columns 5-6).

In reference to claim 4, Gilbert shows a terminal apparatus (Figure 1- sender) comprising:

- Transmitting device transmitting transmission information prepared for a plurality of receivers (i.e. via network connection; column 3, lines 58 to column 4, line 16) including all of the transmission information and information predetermined for respective receivers (i.e. identifier codes; column 6, lines 10-31; column 7, lines 8-24), wherein the information is designated by the sender and different for respective receivers (e.g. John is identified with "a" and Fred identified with "b"; column 8, lines 1- 43; Figure 5); and
- An indication device (i.e. software program executing on networked computer of sender; column 4, line 30 to column 5, line 5) indicating E-mail information that emphasizes and highlights different parts of the transmission information for respective receivers; preparing E-mail

- information for respective receivers including all of the transmission information (columns 6-7); and
- Transmitting the E-mail information for respective receivers, with all of the transmission information sent to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach a storing device storing, independent of receiving the transmission information, keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a system for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device, independent of receiving the transmission information, keyword information predetermined for respective receivers (i.e. pre-defined keyword list used to route messages to particular agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known storing device element of the email system for emphasizing recipient-specific content, as taught by Gilbert, with the known element of storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to there respective functions to yield the predictable

result of subsequently highlighting predetermined keywords associated with respective users that are included in Emails.

In reference to claim 5, Gilbert discloses developed software program including instructions to carry out the recipient specific email methods on computing systems (column 4, lines 16-67). As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information for respective receivers. Therefore, Gilbert teaches a system comprising executable code that specifically implements the previously stated functions. This is equivalent to the software program disclosed by the applicant. Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a system for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device storing information independent of receiving the transmission information, keyword information predetermined for

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respective receivers (i.e. pre-defined keyword list used to route messages to particular agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known information for emphasizing recipient-specific content, as taught by Gilbert, with the known element of storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to their respective functions to yield the predictable result of subsequently highlighting predetermined keywords associated with users that are included in Emails.

In reference to claim 6, Gilbert shows a method (Figures 2&4; columns 4-7) comprising:

- Preparing transmission information to be transmitted from a sender to a plurality of receivers (Figure 2-item 60); and
- Emphasizing and highlighting the transmission information for respective receivers (Figure 2-items 64-68);
- Preparing E-mail information for respective receivers, (Figure 2-item 72);
- Transmitting the E-mail information including all of the transmission information to all respective receivers, (Figure 2-item 73);
- Emphasizing and displaying the transmission information for respective receivers, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission

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information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a method for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device, independent of receiving the transmission information, keyword information predetermined for respective receivers (i.e. pre-defined keyword list used to route messages to particular agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known information for emphasizing recipient-specific content, as taught by Gilbert, with the known element of storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to there respective functions to yield the predictable result of subsequently highlighting predetermined keywords associated with users that are included in E-mails.

In reference to claim 7, Gilbert explicitly discloses an E-mail system (Figure 1), comprising:

- Receiving means (Figure 1-receiver) for receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of

receivers, transmitting means for transmitting the E-mail information for each receiver (column 3, line 24 to column 4, line 30); and

- Emphasizing means (i.e. network computer of sender) for emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67) the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing the email (i.e. embedding text format commands) for respective receiver (columns 5-7),
- Transmitting the E-mail information including all of the transmission information to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a system for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device, independent of receiving the transmission information, keyword information predetermined for respective receivers (i.e. pre-defined keyword list used to route messages to particular

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agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known element for emphasizing recipient-specific content, as taught by Gilbert, with the known element of storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to there respective functions to yield the predictable result of subsequently highlighting predetermined keywords associated with users that are included in Emails.

In reference to claim 8, Gilbert discloses the E-mail system with recipient-specific content system includes:

- A system (Figure 1) for propagating a signal from a propagating computer (i.e. Figure 1-sender) to receiver computers (i.e. Figure 1-receiver), (i.e. via network; Figure 1-item 10) the propagating computer of the system comprising a program (i.e. software program; column 4, lines 30-67),

As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information including all of the transmission information to respective receivers.

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission

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information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a system for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device, independent of receiving the transmission information, keyword information predetermined for respective receivers (i.e. pre-defined keyword list used to route messages to particular agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known element of emphasizing recipient-specific content, as taught by Gilbert, with the known element of storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to there respective functions to yield the predictable result of subsequently highlighting predetermined keywords associated with users that are included in Emails.

In reference to claim 9, Gilbert explicitly discloses a method (Figures 2&4; columns 4-7) for recipient-specific content emailing. Gilbert discloses the method to comprise:

- Receiving information for different destinations with the information having different parts (Figure 2-items 60-64);



- Emphasizing the different parts responsive to the destinations (Figure 2-item 68-72; Figure 3);
- Sending all of the information by email to all the destinations with each destination receiving all of the information, to with at least one of the parts emphasized responsive to the destination (Figure 2-item 73); and
- Displaying the information with one of the parts emphasized at least one of the destinations, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

Gilbert shows substantial features of the claimed invention. However, Gilbert does not teach information independent of receiving the transmission information, predetermined for respective receivers and subsequently emphasizing this information in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Armstrong.

In an analogous art, Armstrong discloses a method for processing emails based on the presence of predetermined terms in the message (abstract). Armstrong further discloses a storing device, independent of receiving the transmission information, keyword information predetermined for respective receivers (i.e. pre-defined keyword list used to route messages to particular agents; Figure 2a-item 135; column 5, lines 47-56; column 6, line 44-column 7, line 5). Thus, it would have been obvious to one of ordinary skill in the art to combine the known element for emphasizing recipient-specific content, as taught

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by Gilbert, with the known element for storing predetermined keyword information for respective receivers, as taught by Armstrong, without change to there respective functions to yield the predictable result of subsequently highlighting predetermined keywords associated with users that are included in Emails.

In reference to claim 10, Armstrong teaches the method wherein the keyword information is stored in tabular form (i.e. keyword list database; column 5, lines 47-56; Figure 2a-item 135).

### ***Conclusion***

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/LaShanya R Nash/  
Examiner, Art Unit 2153  
March 19, 2008

/Glenton B. Burgess/  
Supervisory Patent Examiner, Art  
Unit 2153